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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,988	11/18/2003	James J. Fitzgibbon	5569/79076 (03-31)	4889
22242 7590 03/05/2009 FITCH EVEN TABIN AND FLANNERY 120 SOUTH LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406				
EXAMINER HOLLOWAY III, EDWIN C				
ART UNIT		PAPER NUMBER		
2612				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/715,988

**Applicant(s)**

FITZGIBBON ET AL.

**Examiner**

Edwin C. Holloway, III

**Art Unit**

2612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 7, 11, 12, 14, 17, 18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7, 11, 12, 14, 17, 18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***EXAMINER'S RESPONSE***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 December 2008 has been entered. Claims 1-2, 4, 7, 11-12, 14, 17-18 and 21 are pending. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that the claims are unpatentable for the reasons set forth in this Office action:
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

3. Claims 1-2, 4, 7, 11-12, 14, 17-18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has identified support for the amended claims in the specification as originally filed to be pars. 0021 and 0035 (page 6 line 1+ and page 10 line 1+). The examiner's position is that support is lacking for at least "without consideration of alternative actions

or maintenance of actuation of the close button to effect closure of the barrier." At least pars. 0035-0037 (page 10 lines 1-25) are concerned with a specific action performing multiple functions that is interpreted as consideration of alternative actions. Applicant's original fig. 6 shows three alternative movements in response to this button. At least pars. 0035-0037 (page 10 lines 1-25) are concerned with a performing certain functions during certain times and/or functions that vary with time that at least suggest consideration of maintenance of actuation. Applicant's originally filed disclosure does not particularly point out the exclusion of the limitation in the claimed without clause.

Applicant should specifically point out support in the original disclosure for the new or amended claims. See MPEP 714.02 and 2163.06.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-2, 4, 7, 11-12, 14, 17-18 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding amended independent claims 1 and 11, the new limitation "without consideration of alternative actions or maintenance of actuation of the close button to effect closure of the barrier" has no clear meaning. The negative, alternative (or) language is confusing. The independent claims are contradicting the dependent claims, such as 7,17,18,21) being concerned with alternative actions (change function, stop) and

time periods/delays.

***Claim Rejections - 35 USC § 102 & 103***

6. Claims 1-2, 4, 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Michel (US 5656900).

Regarding claims 1 and 11, Kaplan discloses an entry control system (100) for permitting authorized users to access a controlled area by moving a barrier, comprising:

a push-button switch 38 generating a coded electrical signal when actuated by a user {col. 4, lines 47-61} and the button operating as a close button generating a close signal (col. 10 lines 56-63);

an entry request device (keyboard 20, col. 4, lines 47-61) for accepting a user authorization code (coded signal sequence, col. 5 lines 9-26);

a controller 22 operably coupled to the entry request device and the close button having an output (fig. 1, col. 5 lines 9-26),

such that the controller receives and authenticates the authorization code (col. 5 lines 9-26) and wherein the close button and the entry request device are disposed in a housing (keyboard housing mounted on door jam in fig 1 and col. 4 lines 47-61, and the receipt of the close signal from the close button automatically causes the controller to issue a close barrier signal at the output in order to close the barrier without the need to authenticate any user authorization code (col. 10 lines 56-63).

Kaplan discloses in col. 10 lines 56-63 that pressing single button may be sufficient to close the door, while pressing a sequence of at least three button inputs is

required to authenticate the user to open the door. The single button for closing the door is a close button without authentication as interpreted in light of applicant's disclosure (pg. 9 lines 19-34 and col. 11 lines 3-18). This single button close operation provides the new limitation of "without consideration of alternative actions or maintenance of actuation of the close button to effect closure of the barrier" to the extent understood because Kaplan does not require the button to be continuously pressed.

Kaplan differs from claims 1 and 11 by disclosing a wired connection between keypad 20 and controller 22 instead of the wireless coupling of applicant's claims, but Kaplan does disclose a radio receiver 32 to generate a command signal to open and close the door upon detection of an appropriate radio signal from a wireless radio transmitter (col. 5 lines 27-37). The receiver 32 generates a control signal and is therefor considered to be a controller similar to control unit 22 that also generates a control signal.

Michel discloses analogous art remotely controlled garage door operator to open and close a door in response to a keypad radio transmitter in figs. 1-2 and col. 2 lines 30-52. The keypad is an entry request device and control unit 70 is a controller wirelessly coupled to the keypad.

Regarding claims 1 and 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Kaplan a radio keypad transmitter as disclosed in Michel for wireless communication to the controller suggested by Kaplan disclosing a radio receiver 32. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included

closing of the door in Michel in response to depressing a single key on the keypad as taught by Kaplan for simplified operation.

Regarding claims 2 and 12, a barrier operator (motor 28) communicatively coupled to the controller at the output, the barrier operator receiving the close barrier signal is disclosed in col. 5 lines 9-26 of Kaplan. Michel also includes a motor 72 coupled to a controller 70.

Regarding claims 4 and 14, the entry request device is a small keyboard (20, col. 4 lines 39-61 of Kaplan) also called a keypad. Michel also includes a keypad.

Regarding claim 8, a detector (radio receiver 32) for detecting an RF-ID (radio signal), and wherein the close barrier signal is not transmitted unless the controller detects an RF-ID (col. 5 lines 27-37 of Kaplan). Michel also includes a radio receiver 60.

7. Claims 1-2, 4, 8, 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Heitschel (US005576701A).

Kaplan was discussed above to include all the limitations of claims 1 and except that Kaplan discloses a wired connection between keypad 20 and controller 22 instead of the wireless coupling of applicant's claims.

Heitschel discloses an analogous art garage door operator system with controller 78 wireless coupled to keypad transmitter 25. See figs. 1, 7 and 9. Wireless coupling allows remote access, while input of a four digit code on the keypad prevents access by a theft. See figs. 1, 7 9 and col. 6 lines 16-30.

Regarding claims 1 and 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the system of Kaplan a keypad wirelessly linked to a controller as disclosed by Heitschel for the same purpose of controlling a barrier wherein entry of a code by key presses prevents use by a thief, and suggested by Kaplan disclosing a radio receiver 32. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included closing of the door in Heitschel in response to depressing a single key on the keypad as taught by Kaplan for simplified operation.

Regarding claims 2 and 12, a barrier operator (motor 28) communicatively coupled to the controller at the output, the barrier operator receiving the close barrier signal is disclosed in col. 5 lines 9-26 of Kaplan. Heitschel also includes a motor (door apparatus 11) coupled to a controller 18.

Regarding claims 4 and 14, the entry request device is a small keyboard (20, col. 4 lines 39-61 of Kaplan) also called a keypad. Heitschel also includes a keypad.

Regarding claim 8, a detector (radio receiver 32) for detecting an RF-ID (radio signal), and wherein the close barrier signal is not transmitted unless the controller detects an RF-ID (col. 5 lines 27-37 of Kaplan). Heitschel also includes a decoder 76.

8. Claims 7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Michel (US 5656900) or Heitschel (US005576701A) as applied above in combination with Matsuoka (US 4365250).



Regarding claims 7 and 17-18, the combination applied above does not expressly disclose the limitation of wherein the close button changes function after a predetermined time period.

Matsuoka discloses an analogous art garage door operation control apparatus wherein the close button changes function after a predetermined time period. Operation of a command changes function from downward movement (302, close) to stationary (303, stop) in response to a sequence of operation command inputs (col. 4 lines 44-64). The operation command may be input by a pushbutton switch with a time delay TM4 between each command (col. 8 lines 3-33). Therefore, the function changes after time TM4. This allows manual stopping and reversing direction of the door. Such operation may be provided to for safety.

Regarding claims 7 and 17-17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above changing the button function from close/down to stop after a time period as disclosed in Matsuoka to allow stopping the door for safety and/or for partial closing.

7. Claims 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (US 4408251) in combination with Michel (US 5656900) or Heitschel (US005576701A) as applied above in combination with Ligman (US 4206491) or Lee (US 4369399) or Apple (US 4305060).

Regarding claim 21, the combination applied above does not expressly disclose the limitation wherein the generation of the close barrier signals is delayed for a

predetermined time after the actuation of the close button.

Ligman discloses an analogous art entry system that may be used with garage door operation (col. 8 lines 10-12) wherein a debounce delay 106 is provide between user input and generation of a control signal to prevent false input due to low power or noisy signal. See fig. 8 col. 7 lines 9-35.

Lee discloses an analogous art garage door controller with debounce eliminator 148 connected to button 110 that provides a delay as in Ligman. see fig. 10 and col. 11 lines 51-62.

Apple (US 4305060) discloses an analogous art garage door operator where a delay is provided to allow comparison of a plurality of input codes so that a plurality of matches are required and a limited number of mismatches are allowed before a control signal is output. This maintains security while allowing for interference. See the abstract and col. 2 line 60 - col. 3 line 10.

Regarding claim 21, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the claimed delay in view of the delay in Ligman, Lee or Apple to avoid false input due to low power, noise or interference.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-2, 4, 7, 11-12, 14, 17-18 and 21 filed 15 December 2008 have been considered but are not persuasive and/or are moot in view of the new ground(s) of rejection.

New 35 USC 112 rejections were necessitated by applicant's amendment.

Applicant should point to support in the original disclosure the amended language.

The argument that Kaplan teaches away from the combination with Tolson or Heitschel is incorrect because Kaplan includes wireless communication that suggests the combination.

Applicant argues that the keypad of Kaplan always uses a wired connection that could not operate wirelessly. This argument is not persuasive because Kaplan includes a radio receiver to receive codes from a transmitter. The prior art in col. 1 lines 37-57 of Kaplan includes wired coupling that is easily tampered with by shorting the wires. The invention of Kaplan reduces such tampering by using a coded signal sequence responsive to keypad/keyboard operation. The wireless link would also provide coded signals that would avoid the problem of tampering by shorting a wired link. Heitschel and Michel disclose such a transmitter also including a keypad.

Applicant states that receiver 32 of Kaplan may transmit a control signal from control unit 22 to motor 28. This is incorrect. Kaplan does disclose a radio receiver 32 to generate a command signal to open and close the door upon detection of an appropriate radio signal from a wireless radio transmitter (col. 5 lines 27-37). The receiver 32 generates a control signal and is therefor considered to be a controller similar to control unit 22 that also generates a control signal.

The argument that Kaplan teaches directly away from wireless communication from a keypad by requiring specific sequences or types of button presses by resistance or

press timing is not persuasive because Kaplan expressly discloses a use of wireless communication that may use a keypad in view of Heitschel or Michel. Wireless communication would not be a fundamental change in view of Kaplan expressly disclosing wireless communication. Further, col. 6 lines 35-43 of Kaplan clearly states that the keyboard generated "coded signals" are not limited to resistance levels, but may include any combination of resistors, inductors or capacitor. The examiner contends that such would correspond to frequency generating circuits such as RF oscillators. This section of Kaplan also refers to using voltage references corresponding to amplitude modulated RF signals.

Applicant's arguments regarding Tolson are moot since Tolson is no longer applied in the rejections.

The argument that Heitschel lacks transmit resistance or timing is not persuasive because Heitschel transmits a coded signal analogous to the coded signal of Kaplan. Applicant argues that the mere suggestion of wireless transmission of coded information does not make it likely that one of ordinary skill in the art would modify the device of Kaplan to send resistance setting wirelessly against the express teaching that two wire connection is preferred as a secure method of control. This argument is not persuasive because Kaplan does expressly disclose a wireless link and Kaplan does not make any suggestion that the wireless link is any less secure than wired links that key be easily tampered with my mere shorting. Further, the coded signal of Heitschel would included pulses with particular amplitudes detected as voltage levels and frequencies

corresponding to complex impedances.

In response to applicant's argument that combination of Kaplan and Heitschel would change the principle of operation of Kaplan, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Heitschel and Michel teach keyboard transmitters to open/close a barrier and it would have been obvious to have closed the door in response to a press of a single key on the keypad for simplified operation as disclosed in Kaplan.

The argument that neither Matsuoka, Ligman, Lee nor Apple remedy the deficiency of Kaplan lacking wireless coupling is not persuasive because the combination of Kaplan with Tolson or Heitschel remedies the deficiency.

The argument that Apple does not even relate to moveable barrier operators is incorrect because Apple refers to automatic garage door operators in the ABSTRACT. Further, Apple includes code select 5 in the form of a plurality of two position switches that is analogous to a keypad or keyboard.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meierdierck (US 4935736) disclose a radio remote control

transmitter with dedicated function keys with resistors to identify each key.

***CONTACT INFORMATION***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman, can be reached on (571) 272-3059.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/5/2009  
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